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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/786,169 | 02/26/2004 | Andreas Hayden | 080437.53242US | 3465 |

23911 7590 03/13/2007
CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON, DC 20044-4300

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| EXAMINER |
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TO, TUAN C

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| ART UNIT | PAPER NUMBER |
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3663

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 03/13/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/786,169

Applicant(s)

HAYDEN, ANDREAS

Examiner

Tuan C. To

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-25 is/are pending in the application.
- 4a) Of the above claim(s) 14 and 21-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 8-20 in the reply filed on 12/14/2006 is acknowledged. The traversal is on the ground(s) that the lack of unity standard is not applicable to the present application.

This is not found persuasive because the following:

The applicant inventions do not fall within the permissible invention categories of PCT Rule 13.2 and 37 CFR 1.475:

"In applying PCT Rule 13.2 to international applications as an International Searching Authority, an International Preliminary Examining Authority and to national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2" (MPEP section 1850).

An action on claims 8-20 follows:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 8, and 15-20 are rejected under 35 U.S.C. 102 (b) as being anticipated by Ishiguro et al. (US 5949375A).

Regarding claims 8 and 15, Ishiguro et al. teaches a navigation system/method in which the program instructions are read out of a data carrier which is the CD-ROM, a ROM, a DVD, a floppy disk or the like (Ishiguro et al., figure 1; column 10, lines 4-10, programs instructions stored in the data carrier such as CD-ROM, DVD are read out by the present calculating apparatus 4), causing the system controller (4) (see figure 1) stores in the memory RAM (8) various data including route data, the ROM (7) stores control programs), the data stored on the data carrier such as CD-ROM, DVD, has been read out, wherein the stored data includes map data, control programs, etc (Ishiguro et al., column 12, lines 25-34).

Regarding claim 16, Ishiguro et al. teaches a method of inputting control unit data into a control unit in a vehicle comprising: reading by a reader unit, the control unit data out of a data carrier (Ishiguro et al., figure 1; column 10, lines 4-10, programs instructions stored in the data carrier such as CD-ROM, DVD are read out by the present calculating apparatus 4), communicating the program instructions to the unit (4) via the data bus (9), storing the program instructions in a memory associated with the unit (4) (Ishiguro et al., figure 1, ROM 7, RAM 8). It is noted that the program instructions discloses in Ishiguro et al. is a computer program instructions therefore they should be program code for sequence control.

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As to claim 17, Ishiguro et al. teaches the on-board navigation system (Ishiguro et al., abstract).

As to claim 18, Ishiguro et al. teaches that data carrier comprises CD-ROM, DVD.

As to claim 19, Ishiguro et al. further teaches that data carrier contains control unit data (program instructions) applicable to a plurality of vehicles, and said act of reading is controlled by a microprocessor which reads vehicle characterizing information from a memory, and causes said reader unit to read from said carrier, only control unit data that are applicable to particular vehicle control units (Ishiguro et al., figure 1, the program instructions stored in the data carrier CD-ROM or DVD is read out via the CD-ROM drive (11) and are processed by the computer (4)).

As to claim 20, Ishiguro et al. further teaches: "characterizing information is stored in a memory maintained by a manufacturer of the vehicle (Ishiguro et al., column 12, lines 41-47, the ROM (7) is a volatile memory originally stores control program which is originally maintained by a manufacturer of the vehicle).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishiguro et al. (US 5949375A) and in view of Brody (US 20010051928A1).

Ishiguro et al teaches the limitations of claim 8 except for "the control unit data stored on the data carrier is encrypted, the control unit data is protected against falsification". Brody teaches that the software stored on the data carrier such as CD-ROM is encrypted, the software is protected against falsification (Brody, paragraph 0013).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system/method as taught by Ishiguro et al. to include the teachings of Brody in order to protect the software from unauthorized copying and distribution.

Response to Arguments

Applicant's arguments with respect to claims 8-13, and 15-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusions

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan C To whose telephone number is (571) 272-6985. The examiner can normally be reached on from 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner,

A handwritten signature in black ink, appearing to read 'Tuan C To', is written over a horizontal line.

Tuan C To

March 7, 2007